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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/458,646	12/09/1999	RICHARD S. SCHWERDTFEGER	AT9-99-732	9114

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EXAMINER	
QUELER, ADAM M	

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2178	7

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/458,646	Applicant(s) SCHWERDTFEGER ET AL.	
	Examin r Adam M Queler	Art Unit 2178	

-- The MAILING DATE of this communication app ars on the cov r sheet with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11,12,14-20,22-27 and 29-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,11,12,14-20,22-27 and 29-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment B filed 11/3/2003

2. Claims 1-9,11,12,14-20,22-27 and 29-39, are pending in the case. Claims 1, 14, 22, 27, 30, and 37-39 are independent claims.

3. The indicated allowability of claims 38 and 39 is withdrawn in view of the newly discovered reference(s) to Gounares. Rejections based on the newly cited reference(s) follow. In addition, the previous Office Action indicated there was allowable subject matter in claim 13, and analogous claims. Applicant has added the limitations of claims 10 and 13 into every independent claim, however did not add the limitations of the intervening claims as required by the Office Action. The amendments have considerably altered the scope of the claims, however the indicated notice allowable subject matter which now resides in several claims, is also withdrawn in view of the newly discovered reference(s) to Gounares.

4. The rejection of claim 4 under § 112 was made in error and has been withdrawn and resubmitted properly as the rejection of claim 5

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention. Although, the formats claimed in claim 4 are mentioned the specification. The specification discloses an invention that relies heavily on DOM trees, which were known to interact with HTML/XML documents. It is not apparent from the specification how one of ordinary skill in the art would adapt these claimed formats to work with a DOM tree, or the instant invention.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claims 1-4, 6-9, 11, 12, 14-20, 22-27 and 29-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raman (USPN 5748186—patented 5/5/1998) and further in view of "Extensible Server Pages (XSP) Layer 1" by Stefano Mazzocchi (published 6/11/99), and further in view of Gounares et al. (USPN 6681370 – Filed 5/19/1999.**

Regarding independent claim 1, Raman discloses receiving the document in a first digital format (col. 4, ll. 39-34). Raman teaches that these documents will include an element (FIG. 3). Raman teaches the elements are stored within a data structure (col. 4, ll. 48-49). Inherently, to be stored in a computer system they must be given some type of unique identifier for example, a variable name, or a memory location. Raman teaches using the script to present the document (col. 3, ll. 8-11). Raman does not explicitly disclose producing a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a second digital format, including a portion of an original document expressed in a second digital format, with identifiers

for elements (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects.

Neither Raman nor Mazzocchi disclose using a modification script. Gounares teaches a client machine that receives a modification script in response to an event (col. 9, ll. 46-52). Gounares also teaches using the modification script to modify the presented part of the document (col. 9, ll. 52-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gounares with Raman and Mazzocchi as Raman and Mazzocchi provide tools for working with DOM trees and Gounares uses DOM trees as it's underlying structure (Gounares, col. 7, ll. 7-8).

Regarding dependent claim 2, Raman teaches storing the element (col. 4, ll. 48-49), and inherently the identifier as described in claim 1.

Regarding dependent claim 7, Raman teaches forming a model of a logical structure of the document (col. 4, ll. 55-64). Raman does not explicitly disclose translating a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a script representation, of a DOM tree (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects. It would have been further obvious to provide the script so that it could be used.

Regarding dependent claim 10, Raman teaches a client (col. 3, ll. 66-67). Raman also teaches using the script to present the document (col. 3, ll. 8-11).

Regarding dependent claim 11, Raman teaches generating an event in response to user input (col. 6, ll. 30-32). Raman also teaches associating the event with an element, which has an inherent identifier (col. 7, ll. 33-43). Raman does not teach providing the event and the identifier to the transcoded. Gounares also teaches the event is generated in response to user input and associated with an element in the original document c8.6-11. Gounares teaches presenting the event and it's identifier to be transcoded (col. 9, ll. 52-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gounares with Raman and Mazzocchi as Raman and Mazzocchi provide tools for working with DOM trees and Gounares uses DOM trees as it's underlying structure (Gounares, col. 7, ll. 7-8).

Regarding independent claim 14, Raman discloses receiving the document in a first digital format (col. 4, ll. 39-34). Raman teaches that these documents will include an element (FIG. 3). Raman teaches the elements are stored within a data structure (col. 4, ll. 48-49). Inherently, to be stored in a computer system they must be given some type of unique identifier for example, a variable name, or a memory location. Raman teaches forming a model of a logical structure of the document (col. 4, ll. 55-64). Raman teaches a client (col. 3, ll. 66-67). Raman teaches using the script to present the document (col. 3, ll. 8-11). Raman does not explicitly disclose translating a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a script representation, of a DOM tree (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects. It would have been further obvious to provide the script so that it could be used.

Neither Raman nor Mazzocchi disclose using a modification script. Gounares teaches a client machine that receives a modification script in response to an event (col. 9, ll. 46-52). Gounares also teaches using the modification script to modify the presented part of the document (col. 9, ll. 52-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gounares with Raman and Mazzocchi as Raman and Mazzocchi provide tools for working with DOM trees and Gounares uses DOM trees as it's underlying structure (Gounares, col. 7, ll. 7-8).

Regarding dependent claims 11 and 15, Raman teaches generating an event in response to user input (col. 6, ll. 30-32). Raman also teaches associating the event with an element, which has an inherent identifier (col. 7, ll. 33-43). Raman does not teach providing the event and the identifier to the transcoded. Gounares also teaches the event is generated in response to user input and associated with an element in the original document c8.6-11. Gounares teaches presenting the event and it's identifier to be transcoded (col. 9, ll. 52-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gounares with Raman and Mazzocchi as Raman and Mazzocchi provide tools for working with DOM trees and Gounares uses DOM trees as it's underlying structure (Gounares, col. 7, ll. 7-8).

Regarding dependent claims 12 and 20, Raman teaches accessing the model for usage (cols 6-7). This inherently must be done with an identifier. Raman teaches transcoding the document (col. 3, ll. 8-11)). Neither Raman nor Mazzocchi teach producing the script. Gounares teaches using the model to generate the modification script (Fig. 5). Tree data (514), that is the model, is used to create the modification script. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gounares with Raman and Mazzocchi as Raman and

Mazzocchi provide tools for working with DOM trees and Gounares uses DOM trees as it's underlying structure (Gounares, col. 7, ll. 7-8).

Regarding independent claim 22, the transcoder proxy comprising the system of claim 14 is rejected under the same rationale.

Regarding dependent claim 23, Raman teaches receiving access commands, used for accessing (col. 7), and providing in the first format (col. 7, ll. 50-58).

Regarding dependent claim 24, the receiving and translating of a second potion is taught by the combination of Raman Mazzocchi, and Gounares as being the same process for the first portion, as taught in claim 22.

Regarding dependent claims 4, 19, and 26, Raman teaches the first format is HTML (col. 3, ll. 40-42).

Regarding independent claim 30, Raman discloses receiving the document in a first digital format (col. 4, ll. 39-34). Raman teaches that these documents will include an element (FIG. 3). Raman teaches the elements are stored within a data structure (col. 4, ll. 48-49). Inherently, to be stored in a computer system they must be given some type of unique identifier for example, a variable name, or a memory location. Raman teaches forming a model of a logical structure of the document (col. 4, ll. 55-64). Raman teaches a client (col. 3, ll. 66-67). Raman teaches an output device and a user agent configured to receive a script, which includes an element and inherently an identifier (FIG. 1). Raman teaches providing output commands to the output device (col. 3, ll. 8-16). Raman does not explicitly disclose translating a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a script representation, of a DOM tree (p. 7-8). It would have been obvious to one of ordinary skill in the

art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects.

Neither Raman nor Mazzocchi teach transcoding a DOM tree. Gounares teaches a client machine creates a transcoded DOM tree (FIG 5, 516n). Gounares also teaches using the modification script to modify the presented part of the document (col. 9, ll. 52-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gounares with Raman and Mazzocchi as Raman and Mazzocchi provide tools for working with DOM trees and Gounares uses DOM trees as it's underlying structure (Gounares, col. 7, ll. 7-8).

Regarding dependent claim 31, Raman teaches generating an event in response to user input (col. 6, ll. 30-32). Raman also teaches associating the event with an element, which has an inherent identifier (col. 7, ll. 33-43). Raman does not teach providing the event and the identifier to the transcoded. Gounares also teaches the event is generated in response to user input and associated with an element in the original document c8.6-11. Gounares teaches presenting the event and it's identifier to be transcoded (col. 9, ll. 52-57). Gounares teaches a modifying in response to a modification script (col. 9, ll. 46-52). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gounares with Raman and Mazzocchi as Raman and Mazzocchi provide tools for working with DOM trees and Gounares uses DOM trees as it's underlying structure (Gounares, col. 7, ll. 7-8).

Regarding independent claim 32, Raman discloses receiving the document in a first digital format (col. 4, ll. 39-34). Raman teaches that these documents will include an element (FIG. 3). Raman teaches the elements are stored within a data structure (col. 4, ll. 48-49). Inherently, to be stored in a computer system they must be given some type of unique identifier for example, a

variable name, or a memory location. Raman teaches forming a model of a logical structure of the document (col. 4, ll. 55-64). Raman does not explicitly disclose translating a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a script representation, of a DOM tree (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects. It would have been further obvious to provide the script so that it could be used.

Regarding independent claim 37, Raman discloses receiving the document in a first digital format (col. 4, ll. 39-34). Raman teaches that these documents will include an element (FIG. 3). Raman teaches the elements are stored within a data structure (col. 4, ll. 48-49). Inherently, to be stored in a computer system they must be given some type of unique identifier for example, a variable name, or a memory location. Raman teaches forming a model of a logical structure of the document (col. 4, ll. 55-64). Raman does not explicitly disclose translating a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a script representation, of a DOM tree (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects. It would have been further obvious to provide the script so that it could be used.

Raman teaches generating an event in response to user input (col. 6, ll. 30-32). Raman also teaches associating the event with an element (col. 7, ll. 33-43). Raman does not teach providing the event and the identifier to the transcoded though it would have been obvious to do so that the event could be properly transcoded.

Raman teaches accessing the model for usage (cols 6-7). This inherently must be done with an identifier. Raman teaches transcoding the document (col. 3, ll. 8-11)). Raman does not teach producing the script.

Neither Raman nor Mazzocchi teach transcoding a DOM tree. Gounares teaches a client machine creates a transcoded DOM tree (FIG 5, 516n). Gounares also teaches using the modification script to modify the presented part of the document (col. 9, ll. 52-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gounares with Raman and Mazzocchi as Raman and Mazzocchi provide tools for working with DOM trees and Gounares uses DOM trees as it's underlying structure (Gounares, col. 7, ll. 7-8).

Regarding dependent claims 8, 16 and 33, Raman teaches methods for access and manipulating the document (cols. 6-7).

Regarding dependent claims 9, 17, and 34, Raman teaches the model is made up out of document objects (col. 4, ll. 61-62), and is therefore a document object model.

Regarding dependent claims 3, 18, 25, and 35, Raman discloses the first format is a text based markup language (col. 3, ll. 40-42).

Regarding dependent claims 6 and 36, Raman does not explicitly disclose translating a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a script representation, including a portion of an original document expressed in a second digital format, with identifiers for elements (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects.

Regarding independent claim 38, Raman discloses receiving the document in a first digital format (col. 4, ll. 39-34). Raman teaches that these documents will include an element (FIG. 3). Raman teaches the elements are stored within a data structure (col. 4, ll. 48-49). Inherently, to be stored in a computer system they must be given some type of unique identifier for example, a variable name, or a memory location. Raman teaches using the script to present the document (col. 3, ll. 8-11). Raman does not explicitly disclose producing a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a second digital format, including a portion of an original document expressed in a second digital format, with identifiers for elements (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects.

Neither Raman nor Mazzocchi disclose using a modification script. Gounares teaches a client machine that receives a modification script in response to an event (col. 9, ll. 46-52). Gounares also teaches using the modification script to modify the presented part of the document (col. 9, ll. 52-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gounares with Raman and Mazzocchi as Raman and Mazzocchi provide tools for working with DOM trees and Gounares uses DOM trees as it's underlying structure (Gounares, col. 7, ll. 7-8).

Raman teaches generating an event in response to user input (col. 6, ll. 30-32). Raman also teaches associating the event with an element, which has an inherent identifier (col. 7, ll. 33-43). Raman does not teach providing the event and the identifier to the transcoded. Gounares also teaches the event is generated in response to user input and associated with an element in the

original document c8.6-11. Gounares teaches presenting the event and it's identifier to be transcoded (col. 9, ll. 52-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gounares with Raman and Mazzocchi as Raman and Mazzocchi provide tools for working with DOM trees and Gounares uses DOM trees as it's underlying structure (Gounares, col. 7, ll. 7-8).

Regarding independent claim 39, Raman discloses receiving the document in a first digital format (col. 4, ll. 39-34). Raman teaches that these documents will include an element (FIG. 3). Raman teaches the elements are stored within a data structure (col. 4, ll. 48-49). Inherently, to be stored in a computer system they must be given some type of unique identifier for example, a variable name, or a memory location. Raman teaches using the script to present the document (col. 3, ll. 8-11). Raman does not explicitly disclose producing a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a second digital format, including a portion of an original document expressed in a second digital format, with identifiers for elements (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects.

Neither Raman nor Mazzocchi disclose using a modification script. Gounares teaches a client machine that receives a modification script in response to an event (col. 9, ll. 46-52). Gounares also teaches using the modification script to modify the presented part of the document (col. 9, ll. 52-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gounares with Raman and Mazzocchi as Raman and Mazzocchi provide tools for

working with DOM trees and Gounares uses DOM trees as it's underlying structure (Gounares, col. 7, ll. 7-8).

Raman teaches generating an event in response to user input (col. 6, ll. 30-32). Raman also teaches associating the event with an element, which has an inherent identifier (col. 7, ll. 33-43). Raman does not teach providing the event and the identifier to the transcoded. Gounares also teaches the event is generated in response to user input and associated with an element in the original document c8.6-11. Gounares teaches presenting the event and it's identifier to be transcoded (col. 9, ll. 52-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gounares with Raman and Mazzocchi as Raman and Mazzocchi provide tools for working with DOM trees and Gounares uses DOM trees as it's underlying structure (Gounares, col. 7, ll. 7-8).

9. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Raman, Mazzocchi, and Gounares as applied to claim 1 above, and further in view of Applicant's Admitted Prior Art.

Regarding dependent claim 5, Raman and Mazzocchi are silent as to PDF, AFP, and postscript documents. Applicant admits that these formats were well-known digital formats (p. 17-19). It would have been obvious to one of ordinary skill in the art at the time of the invention to include these formats so more types of documents could be used with the invention.

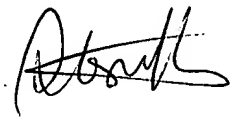
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (703) 308-5213. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ



STEPHEN S. HONG
PRIMARY EXAMINER